

REMARKS/ARGUMENTS

Claims 3-6 remain pending in the instant application. Favorable reconsideration is kindly requested.

Interview Summary

Applicant gratefully acknowledges the courtesy of Examiners S. Afzali and D. Bryant in granting a telephone interview with the Applicant's representative, which was held Thursday December 4, 2008. The following is a summary of the interview.

Applicant presented a brief synopsis of the exemplary embodiment disclosed in the specification and its features and advantages. Applicant then argued that, for example, Buckwalter does not teach or suggest an outer tensioning roller, nor a running disk made of steel. Applicant also observed that even if the features of claims 3-4 are considered as product-by-process, the Office Action does not identify corresponding structure in the combined references that meets the structure that is the result of the alleged process steps. Finally, Applicant observed that the dimensions recited in claims 5 and 6 are not merely arbitrary, but are only one pair of such dimensions that meet the characteristics of underlying claims 3 and 4, respectively.

Examiners Afzali and Bryant agreed that at least claims 3 and 4 were distinguished if presented in independent form, and also amended to include proper antecedent basis for "the contraction of the inner machine part".

Amendments to the Claims

As amended above, independent claim 1 is cancelled without disclaimer or prejudice to the subject matter thereof, nor to its subsequent re-introduction in this or a continuing application, and without acquiescing in the propriety of the rejection. Claims 3 and 4 are amended into independent form, including the features of their underlying independent base claim 1, and are further amended to recite "the inner machine part is subject to a contraction". No new matter has been added.

Rejection under 35 U.S.C. § 103(a)

Claims 1 and 3-6 have been rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,267,712 to Franke ("Franke"), in view of U.S. Patent No. 1,643,977 to Buckwalter ("Buckwalter"). Applicant respectfully traverses the rejection, for at least the following reasons.

In view of the amendment above canceling claim 1, applicant respectfully submits that the rejection of that claim is now moot.

Turning then to claims 3 and 4, these claims recites structural material properties of the inner and outer machine parts recited therein. However, the Office Action incorrectly characterizes them as product-by-process limitations. A process requires some step; something done that can be defined using an action verb. Selecting a characteristic is hardly such a process step.

Even assuming, which Applicants do not, that the features of claims 3 and 4 are correctly characterized as product-by-process, the Office Action is still obliged to point to a teaching in the references or knowledge generally available to one skilled in the art that the resulting structure of the recited process is present. The Office Action does not even allege that the purported combination of Franke and Buckwalter yields a structure having the properties that result from the putative product-by-process features of claims 3 and 4.

Therefore, Applicant respectfully submits that the Office Action fails to make out a *prima facie* case of obviousness of claims 3 and 4, and for that reason further requests withdrawal of the rejection. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Turning to claims 5 and 6, Applicant respectfully submits that the Office Action has inappropriately simplified the features of claims 5 and 6 to mere arbitrary dimensions. Claims 3 and 4 recite that a first thickness is selected such that, where the outer part is deformed radially outward into the plastic range of material strain, the contraction induced in the complementary inner part corresponds to the contraction induced by an outer part of predetermined greater thickness in the case that the outer part of a predetermined greater thickness were to remain in elastic deformation. Claims 5 and 6 further limit claims 3 and 4, respectively, by selecting a subset of the dimensional pairs (external diameter of the inner machine part/raceway ring, and wall thickness of the outer machine part/running disk) within the set meeting the features defined by claims 3 and 4. Therefore, the relevant question with respect to claims 5 and 6 is not merely whether it would have been obvious to select an inner machine part external diameter of approximately 55mm, or an outer machine part wall thickness of about 1.5mm, but what teachings in the prior art would lead one of ordinary skill in the art to select both recited dimensions, that also meet the features of underlying claims 3 and 4, respectively. Applicants respectfully submit that there are none.

Applicants respectfully submit that, absent the impermissible hindsight application of their own disclosure, there is no apparent reasons for one of ordinary skill in the art to modify the purported combination of Franke and Buckwalter to arrive at the structure recited in claims 5 or 6. To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 312-313 (Fed. Cir. 1983). Applicant kindly requests favorable reconsideration and withdrawal of the rejection.

In addition, solely for the purpose of completing the record, in the event that further prosecution is necessary, Applicant respectfully traverses that “the particular dimensions of the raceway ring and running disk” are proper subjects of Official Notice, and kindly requests citation to documentary evidence of the same if the rejection is to be maintained.

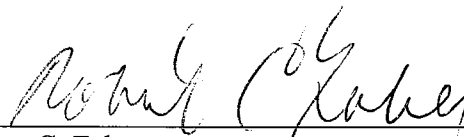
Conclusion

In light of the foregoing, Applicant respectfully submits that all claims are patentable, and kindly solicits and early and favorable Notice of Allowability.

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RCF/DJT:lf

Respectfully submitted,



Robert C. Faber
Registration No.: 24,322
OSTROLENK, FABER, GERB & SOFFEN, LLP
1180 Avenue of the Americas
New York, New York 10036-8403
Telephone: (212) 382-0700